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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/855,117	05/14/2001	Steven T. Kanefsky	108874	9063

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EXAMINER

TANG, KAREN C

ART UNIT	PAPER NUMBER
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2151

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/855,117

Applicant(s)

KANEFSKY, STEVEN T.

Examin r

Karen C Tang

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 5/14/01 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5/14/01</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-17 rejected under the judicially created doctrine of double patenting over claims 1-28 of U. S. Patent No. 6,603,984 since the claims, if allowed, would improperly extend the "right to exclude" already granted in the patent.

The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows:

Wireless device which comprises receiving, designating a folder base on the search operation, and performing menu navigation. It also consists ability to navigate to a second menu and consists one or more query operation. The scripts operation can accessing information relating to an external network in response to the query.

Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of

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the application which matured into a patent. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

I. Claims 1-17 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-28 of prior U.S. Patent No. 6,603,984. This is a double patenting rejection.

Claim(s) 1-28 of patent # 6,603,984 contain(s) every element of claim(s) 1-5, 7-9, 11,15, and 17 of the instant application and as such anticipate(s) claim(s) 1-17 of the instant application.

Claims(s) 6, 7, 13 and 14 are inherit by Claim(s) 1-28 of patent # 6,603,984, since the patent #6,603,984 indicates that there is a second menu which contains information (Examiner interprets the "information" can be two or more selected items or folders, or search parameters)

"A later patent claim is not patentably distinct from an earlier patent claim if the later claim is obvious over, or **anticipated by**, the earlier claim. *In re Longi*, 759 F.2d at 896, 225 USPQ at 651 (affirming a holding of obviousness-type double patenting because the claims at issue were obvious over claims in four prior art patents); *In re Berg*, 140 F.3d at 1437, 46 USPQ2d at 1233 (Fed. Cir. 1998) (affirming a holding of obviousness-type double patenting where a patent application claim to a genus is anticipated by a patent claim to a species within that genus). " *ELI LILLY AND COMPANY v BARR LABORATORIES, INC.*, United States Court of Appeals for the Federal Circuit, ON

PETITION FOR REHEARING EN BANC (DECIDED: May 30, 2001).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

II. Claims 1-3, and 5-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Deo et al hereinafter Deo (US 6,832,084).

1. Referring to Claim 1, Deo discloses providing information on a wireless device (abstract), providing a search operation using the wireless device (refer to Col 13, Lines 30-35); receiving one or more search parameters (parameters is interpreted as objects in the art, Col 2, Lines 33-45) from the wireless device; designating a folder (refer to Col 11, Lines 25-30, Fig 1) based on the search operation (object is based on the search operation); and performing a menu navigation (refer to Fig 1) to a designation folder directed to the one or more search parameters (audio tones, 258A, 258B, 258C).
2. Referring to Claims 2 and 8, Deo discloses wherein performing a search (refer to Col 13, Lines 30-50) including activating a script (applet code, refer to Col 4,

Lines 15-40) directed to one or more queries (refer to Col 4, Lines 1-15, read and write are type of queries, which is known in the art).

3. Referring to Claims 3 and 11, Deo discloses wherein the designated folder (refer to Col 11, Lines 25-30, Fig 1) is part of a preexisting deck (it is known in the art that the functionality including folders has been pre-installed within the wireless device) used by the wireless device (abstract).
4. Referring to Claim 5, Deo discloses comprising providing a search operation using the wireless device; receiving one or more search parameters from the wireless device; performing a selection operation based on the one or more search parameters (refer to Col 5, Lines 10-25); and providing a second menu (Fig 20, second menu, which the title indicate "contacts") to the wireless device based on the selection operation (from the first menu, Fig 1, the selection operation consists the option "contacts", which the menu navigate to the "contact" menu).
5. Referring to Claims 6 and 13, Deo discloses wherein the second menu (Refer to Fig 20) is a flat menu (GUI or interface) that includes two or more selected items (Different names, refer to Fig 20).

6. Referring to Claims 7 and 15, Deo discloses wherein the second menu (Fig 20) includes at least one text message (names of people, refer to Col 14, Lines 40-65) that contains at least one of the one or more search parameters (address and telephone numbers, refer to Col 14, Lines 40-65).
7. Referring to Claims 9 and 14, Deo discloses wherein the second menu is a hierarchical menu that includes two or more selected folders (Menus is hierarchical, refer to Col 5, Lines 1-10, which is inherit that the, and the user can move through a tree structure. Second menu, refer to Fig 20, consists of list of names as records, which associate to telephone numbers and address are folders or databases that can be two or more folders, refer to Col 14, Lines 40-65).
8. Referring to Claim 10, Deo discloses: an interface that receives one or more search parameters from the wireless device (parameters is interprets as objects in the art, Col 2, Lines 33-45); a search device that performs a search operation based on the one or more search parameters (refer to Col 13, Lines 30-35); and a messaging device (paging, refer to Col 4, Lines 1-16) that provides information to the wireless device based on the search (navigation, refer to Fig 1, "Contact", which is to search to the person's contacting information in able to paging, and bi-directionally, refer to Col 3, Lines 65-67); wherein the wireless device displays one of a designated folder of a preexisting menu displayed at the wireless device

and a portion of a second menu (refer to Fig 20), wherein the second menu is formed based on the provided information (refer to Fig 1, Main Menu).

9. Referring to Claim 12, Deo discloses wherein the wireless device (refer to Abstract) displays a portion of a second menu (Refer to Fig 20), wherein the second menu is formed based on the provided information (Fig 1, Main Menu).
10. Referring to Claim 16, Deo discloses a script processor (CPU, refer to Col 3, Lines 57-67), wherein at least one search parameter is provided in response to a script (applet, refer to Col 4, Lines 1-40) directed to one or more query operations (read and writes).
11. Referring to Claim 17, Deo discloses wherein the one or more script (applet, refer to Col 4, Lines 15-30) operations further include accessing information relating to an external network (downloading information from external source/network, refer to Col 4, Lines 1-16) in response to the query.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

III. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deo et al hereinafter Deo (US 6,832,084) in view of LaDue (US 6,185,198).

1. Referring to Claim 4, Deo discloses wherein the script (applet, refer to Col 4, Lines 1-40) further including one or more operations (read and write).

Deo does not expressly indicate the operation includes performs one of facilitating a purchase (refer to 0113, receive and payable) facilitating a reservation based on the query and placing a phone call.

Ladue indicates the real time billing and debit transaction (purchase) (refer to Col 12, Lines 55-67) by dialing or messaging/paging (refer to Col 13, lines 60-67)

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to combine both Deo and Ladue's invention because it is very efficient for user consists capability to pay billing and purchasing items such as games or ring tone just by pressing the bottom or making phone call.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US 6,757,530 (Rouse et al discloses a system and method for providing wireless device access to scheduling application).
- US 6,026,388 (Liddy et al discloses user interface and other enhancements for natural language information retrieval system and method)

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- US 6,829,348 (Schroeder et al discloses system for customer contact information management and methods for using same)

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen C Tang whose telephone number is (571)272-3116. The examiner can normally be reached on M-F 7 - 3.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571)272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KT


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER